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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DONALD F. GORDON,  
SADIK BAYRAKERI, HAROLD P. YOCUM  
and JERRY WANG

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Appeal 2008-2197  
Application 09/585,263  
Technology Center 2600

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Decided: September 9, 2008

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Before KENNETH W.HAIRSTON, ROBERT E. NAPPI,  
and KARL D. EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-2, 5, 7-10, and 13-14. Claims 3-4, 6, and 11-12 have been

cancelled. No other claims are pending. (*See* App. Br. 5). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' claimed invention relates to a server-centric user interface comprising an interactive program guide (IPG) that is generated in the head end of an information distribution system as a digital video bitstream. The system transmits from the headend a bitmap for a channel information window and broadcast video, and overlays the broadcast video with the window at the terminal end using the bitmap. (Spec. 2: 20-31, Fig. 1).

Claim 1 is illustrative of the invention and reads as follows:

1. A method, comprising:

generating, at a headend, at least one bitmap for a channel information window;

encoding, at the headend, a broadcast video presentation and the bitmap for the channel information window, the broadcast video presentation being programming from one of a plurality of channels;

transmitting, from the headend to a set top terminal, the broadcast video presentation and the bitmap for the channel information window;

receiving, at the set top terminal, a signal to activate the channel information window;

decoding, at the set top terminal, the broadcast video presentation and the bitmap for the channel information window; and

compositing, at the set top terminal, the bitmap for the channel information window and the broadcast video presentation to produce a video stream for a display so that the channel information window overlays and obscures at least a portion of the broadcast video presentation on the display.

The Examiner relies on the following prior art references to show unpatentability:

Hoarty	US 5,485,197	Jan. 16, 1996
Bolanos	US 5,793,364	Aug. 11, 1998
MacInnis	US 5,951,639	Sept. 14, 1999
Ellis	US 5,986,650	Nov. 16, 1999

Claims 1, 2, 5, and 8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ellis.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ellis and Hoarty.

Claims 9, 10, and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ellis and Bolanos.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ellis and MacInnis.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details.<sup>1</sup> Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived *see* 37 C.F.R. § 41.37 (c) (1) (vii).

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<sup>1</sup> We refer to the Appeal Brief, filed February 20, 2007; Reply Brief, filed August 9, 2007, and Answer, filed June 11, 2007.

## PRINCIPLES OF LAW

“It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim.” *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a

*prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

*KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

## ANALYSIS

Regarding the anticipation rejection of claims 1, 2, 5, and 8, Appellants primarily dispute the Examiner’s finding that Ellis discloses “that the bitmap is generated and encoded at the headend.” (App. Br. 13). The aforementioned claims each recite a limitation commensurate in scope to the disputed limitation. As Appellants state: “The Examiner asserts because Ellis teaches that the stored bit maps are downloadable data that the stored bit maps are, therefore, generated and encoded at the headend.” (App. Br. 13, citing the Final Office Action: 2, mailed September 21, 2006).

As Appellants’ indicate, the Examiner reasons that because Ellis teaches downloading from a headend, and encoding, that Ellis discloses encoding a broadcast video and the bitmap at the headend. (Ans. 4-5). The Examiner states: “Ellis clearly states here the bit map data has been downloaded along with the program schedule information, in addition to several other unnamed data types” (Ans. 4, citing Ellis col. 4, ll. 55-67).

“QPSK modulation is inherently a form of encoding . . . and is expressly taught by Ellis as a means by which data is delivered to the receiver from the headend.” (Ans. 5).

Despite the Examiner’s findings, Appellants maintain that “Ellis fails to teach or suggest encoding, at the headend, the bitmap for the channel information window and transmitting, from the headend to the set top terminal, the channel information window. (Reply Br. 2). Appellants reason that the reference “is silent as to where the ‘downloaded’ data types are downloaded from.” (Reply Br. 2). Appellants also contend that Ellis teaches analog modulation, and such analog modulation does not constitute encoding. (App. Br. 14).

We turn to Ellis: “This configuration allows revised or replacement versions of the application software to be downloaded directly from the software developer to the user site through the cable or other transmission system.” (Col. 5, ll. 41-44.). Ellis also refers to “other downloaded data types such as stored bit maps for the screen configuration.” (Col. 6, ll. 31-32).

We find the latter reference above to downloaded data to be included in the former reference to downloaded data, and hence, taught to be downloaded through the cable or other transmission system. Thus, we agree with the Examiner: these descriptions of downloading imply downloading at a headend, notwithstanding Appellants’ contention noted above, that the reference “is silent as to where the ‘downloaded’ data types are downloaded from.” (Reply Br. 2).

However, the downloading finding does not serve to resolve the central issue on appeal: whether the video and the bitmap data are *encoded* at “the headend” as set forth in the claim. In other words, claim 1 requires encoding both the bitmap information and the broadcast video at the same headend, as follows:

generating, at a headend, at least one bitmap for a channel information window;

encoding, at the headend, a broadcast video presentation and the bitmap for the channel information window, the broadcast video presentation being programming from one of a plurality of channels.

Independent claim 5 recites a similar limitation.

We do not find in Ellis a teaching that both the broadcast video and the bitmap are encoded at the same headend as called for in claim 1. We find that Ellis discloses a wide array of data/video sources (col. 4, ll. 46-67), but there is no disclosure that they all are encoded at the same headend.

While we are in general agreement with the Examiner that Ellis discloses that the bit maps are encoded, based on QPSK digital modulation as the Examiner generally found, (Ans. 5, *see* Ellis col. 5, ll. 1-16), we do not find in Ellis, in line with Appellants’ argument that Ellis discloses “transmitting analog data signals” (App. Br. 14), a disclosure that the broadcast video is also digitally encoded as QPSK (*see id.*, and Ellis Fig. 1 – tuner 28 for the broadcast video distinct from data demodulator 13 for QPSK data). We also do not understand the Examiner’s position to be that the broadcast video is QPSK encoded, nor do we find a direct assertion supported by a citation to Ellis that the broadcast video is encoded at all.

Hence, we have no basis for finding that the broadcast video and the bitmap are encoded at the same headend.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Ellis, we will not sustain the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 1 and 5. Since claims 2 and 8 are dependent upon these claims, we also will not sustain the Examiner's 35 U.S.C. § 102(b) rejection of those claims.

As to the obviousness rejections of claims 7, 9, 10, 13, and 14, the Examiner provides no additional findings that the disputed element is taught in either the additional reference of Hoarty for claim 7, Bolanos for claims 9, 10<sup>2</sup>, and 13, or MacInnis for claim 14, but instead relies on findings in Ellis for claim 1. Since we have found Ellis to be lacking as discussed above, we also will not sustain the rejections of claims 7, 9, 10, 13, and 14 for the same reasons as indicated *supra* regarding claim 1, and also because the Examiner has not advanced an "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" as required by *KSR*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d at 988).

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<sup>2</sup> Similar to our analysis of claim 1, since we do not find that the broadcast video is encoded in Ellis, it follows that we do not find decoding as called for in claim 10. We also do not find any disclosure in Ellis that the broadcast video presentation and a bitmap for the channel information window are received from the same headend as further required by claim 10.

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## CONCLUSION

In summary, we do not sustain the Examiner's rejection of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1, 2, 5, 7-10, 13, and 14 is reversed.

REVERSED

KIS

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